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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/718,103	Applicant(s) BAJIKAR ET AL.	
	Examiner John M. Winter	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 46-49 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-8, 46-49 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 46-49 are drawn to accessing storage device, classified in class 710 subclass 1.
 - II. Claims 9-20 are drawn to accessing a data wirelessly with an access key, classified in class 381 subclass 311.
 - III. Claims 21-30 wireless data, classified in class 381 subclass 1.
 - IV. Claims 31-38,43-45 secure channel of communications, classified in class 705 subclass 64.
 - V. Claims 39-42 secure channel with authentication, classified in class 705 subclass 67.

Inventions I -V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 5 806.05(c)). In the instant case, the combination as claimed in invention I does not require the particulars of the subcombination as claimed in inventions II -V such as an a wireless module ,AAA capabilities (invention III), a protected channel of communication (invention IV) and a second key (invention V).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via the paper filed on July 20, 2004 the applicant has elected the examination of invention I directed towards claims 1-8, 46-49. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-8, 46-49 have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the limitation "A3, A8 and A5 algorithms" this limitation is vague and indefinite, no limitation is imposed upon the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooney et al. (US Patent 5,515,440) in view of Trusted Computing Platform Alliance (TCPA) Main Specification Version 1.1b (22 February 2002).

As per claim 1

Mooney ('440) discloses a computing system comprising:

a processor and chipset to provide for protected execution of code;(Column 4, lines 31-44).

a hardware token including a credential data store; (Column 6, lines 12-25)

Mooney ('440) does not explicitly disclose a storage device storing code to implement Subscriber Identity Module (SIM) algorithms, the SIM algorithms to be executed by the processor in a protected partition. TCPA ('616) discloses a storage device storing code to implement Subscriber Identity Module (SIM) algorithms, the SIM algorithms to be executed by the processor in a protected partition (Pages 145-147) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Mooney ('440)'s method with TCPA's teaching in order to limit access to confidential data without proper authentication.

Claim 46 is in parallel with claim 1 and is rejected for at least the same reasons.

As per claim 2

Mooney ('440) discloses the computing system of claim 1 wherein,

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the hardware token is a Trusted Platform Module (TPM). (Column 6, lines 12-25)

As per claim 3

Mooney ('440) discloses the computing system of claim 1 wherein, the processor is a microprocessor, (Column 4, lines 55-57) the computing system is a notebook computer system.(Figure 1)

As per claim 4

Mooney ('440) discloses the computing system of claim 3 wherein, the storage device is one of a hard disk and a compact disc. (Column 4, lines 31-44 [Examiner notes that although the prior art is embodied in an IC card -- from the point of view of most operating systems, e.g. Microsoft Windows etc., an IC card is accessed and presented as a hard disk])

As per claim 5

Mooney ('440) discloses the computing system of claim 3 wherein, the storage device further stores a provisioning algorithm to provide for provisioning of SIM secret data objects. (Column 6, lines 12-25)

As per claim 6

Mooney ('440) discloses the computing system of claim 1 wherein, the computing system executes an operating system that provides for protected software execution.(Abstract)

As per claim 7

Mooney ('440) discloses the computing system of claim 1 wherein, the SIM algorithms include code to execute one or more of a set of algorithms including an authentication algorithm, a cipher key generator algorithm, an encryption algorithm and a decryption algorithm. (Column 6, lines 12-25)

As per claims 47 and 48

Mooney ('440) disclose the computer-accessible storage medium of claim 46, Official Notice is taken that "the application program is to access the SIM capabilities to provide authentication to a network and the network is one of a wireless local area network, a wireless wide area network, and a wired network" is common and well known in prior art in reference to security protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to authenticate a user prior to network access.

As per claim 49

Mooney ('440) discloses the computer-accessible storage medium of claim 46 wherein the application is to access the SIM capabilities to provide location-based services.(Abstract)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 46-49 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-28 of US Patent Application US 2005/0039013 .

Although the conflicting claims are not identical, they are not patentable distinct for the reasons stated below.

As per claims 1-8, 46-49 of the present application,

Claims 1-28 of US Patent Application US 2005/0039013 discloses all of the claimed features of the present application, claims 1-28 of US Patent Application US 2005/0039013 further disclose the additional feature of having multiple authentication factors. It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove a feature from US Patent Application US 2005/0039013 in order to derive the presently claimed invention.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John Winter
Patent Examiner -- 3621



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